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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,249	12/20/2001	Gregory D. May	7000-209	9021
27820	7590	10/05/2005	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C.			WANG, QUAN ZHEN	
P.O. BOX 1287			ART UNIT	PAPER NUMBER
CARY, NC 27512			2633	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/027,249

Applicant(s)

MAY ET AL.

Examiner

Quan-Zhen Wang

Art Unit

2633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-7, 9-12, 14-18, and 20-23.
Claim(s) withdrawn-from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER


11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed on 9/16/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Alexander clearly points out that "Although the embodiment of FIG. 2 shows wavelength selecting device 54 simultaneously outputting each optical channel and the optical noise samples, it is noted that these signals can be output individually (as when using a tunable wavelength selecting device which locks onto desired channel and noise sample wavelengths). As in the case of the optical switch discussed above, this arrangement greatly reduces the number of power meters needed to receive the optical signals output by the wavelength selecting device" (column 4, lines 49-58). The statement clearly shows that fig. 2 is not the only design choice for the system of Alexander. In other words, the system of Alexander can have another alternative arrangement. That indicates that one of ordinary skill in the art would be motivated to substitute the wavelength selecting device with other existing and known wavelength selecting devices. Prohaska discloses a re-configurable wavelength selective device for applications in WDM system (see the background of the invention). In other words, the selecting device of Prohaska is one of the existing and known wavelength selecting devices in the art. Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to incorporate the wavelength select switch taught by Prohaska into the system of Alexander for the wavelength select switch. Applicant further argues that the combination of Alexander and Prohaska did not teach "passing a subset of the optical signals through the wavelength select switch at substantially the same time; and measuring power in the subset of optical signals using the power meter". The Examiner disagrees the argument. As it has been pointed out in the Office Action of 8/24/05, a single channel is selected and dropped from the wavelength selective device of Prohaska, mean while the unselected "subset" wavelengths are also output from the device through another output port (not terminated within the select device). Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to monitor the output signal, including measure the output power of the subset wavelengths. The applicant further argues "measuring the power of a single wavelength is not the same as measuring the power of a subset. However, measuring the power of a subset wavelength is well known in the art. As a matter of fact, the power of a set of wavelengths is often monitored in optical networking systems. For example, Roberts (U.S. Patent US 5,274,596) discloses that the pump power of an optical amplifier may be controlled in response to the power measured in a subset of wavelength bands in the optical signal (column 3, lines 46-58). Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to measure the output power of the subset wavelengths.

In response to applicant's argument that both claims 6 and 17 recite that the optical system comprises a dense Wavelength Division Multiplexing (DWDM) system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, there is no structural difference between the claimed invention and the prior art. Therefore, the prior art meets the claim.

In conclusion, Applicant's arguments are not persuasive and the prior arts teach and suggest all the limitations of the claimed invention. Therefore, the claimed invention is not allowable and the rejection still stands..


M. R. SEDIGHIA
PRIMARY EXAMINER